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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,890	11/18/2003	Edgar A. Dallas	048674-0310	3688

26371 7590 05/05/2005  
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EXAMINER

HAMILTON, ISAAC N

ART UNIT PAPER NUMBER

3724

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/715,890

Applicant(s)

DALLAS ET AL.

Examiner

Isaac N Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04/08/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 12-14, 19, 22-24, 31, 32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 15-18, 20, 21, 25-30 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Species I, claims 1-11, 15-18, 20, 21, 25-30 and 33, in the reply filed on 04/08/2005 is acknowledged.
2. Claims 12-14, 19, 22-24, 31, 32 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 04/08/2005.

### *Drawings*

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "partially offset relationship" in claim 8, line 3, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet"

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pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

4. Claims 11 and 27 are objected to because of the following informalities: the listing of embodiments of the second object should be in the Markush Group format "selecting from the group consisting of...". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 recites the limitation "the receptacle" in line 3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1-5, 8, 10, 15-18, 20, 21, 25, 26, 28, 30 and 33 are rejected under 35

U.S.C. 102(e) as being anticipated by Gringer (6,732,395). Gringer discloses first retainer/magnetic member 35; primary tool/first object 10; second retainer/magnetic member is the top portion juxtaposed the first retainer 35 in figure 13; second object/secondary tool 40; magnetic force supplied by magnet/first retainer 35; first and second polarities are inherent in the attraction between ferrous materials and magnets; receptacle 38, which encases the secondary tool; metallic material in column 3, line 33; magnetic material 35; handle/elongated member 11; substantial alignment of tools in figure 13; it is inherent that the first magnetic member and the second magnetic member are in an at least partially offset relationship due to the secondary tool not being centered on the first magnetic member in the receptacle; the implied magnetic force is more than 4000 gauss in column 4, lines 11-14.

9. Claims 1-5, 8, 10, 16-18, 20, 21, 25, 26, 28, 30 and 33 are rejected under 35

U.S.C. 102(b) as being anticipated by Bridwell (4,268,927). Bridwell discloses first retainer/magnetic member 138; primary tool/first object 20; second retainer/magnetic member is the hexagonal portion juxtaposed the first retainer 138 in figures 11 and 12; second object/secondary tool 150, 152, 154, 156, 158, 160, 162; magnetic force supplied by magnet/first retainer 138; first and second polarities are inherent in the attraction between ferrous materials and magnets; receptacle shown in figure 12, which encases the secondary tool; metallic material in column 6, line 62; magnetic material 138; handle/elongated member 20; substantial alignment of tools in figures 11 and 12; it is inherent that the first magnetic member and the second magnetic member are in an at least partially offset relationship due to the secondary tool not being centered on the first magnetic member in the receptacle.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Regarding claim 9, Bridwell and Gringer disclose the claimed invention except for the first retainer comprising a metallic material and the second retainer comprising a magnetic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the first retainer comprising a metallic material and the second retainer comprising a magnetic material, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. It would have been obvious to provide the first retainer comprising a metallic material and the second retainer comprising a magnetic material in Bridwell and Gringer in order to clean metal particles from the receptacles that hold the tools.

12. Claims 1-11, 16, 17, 20, 21, 25-30, 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall et al (5,701,675), hereafter Hall, in view of Escobedo et al (6,662,531), hereafter Escobedo. Hall discloses primary tool/first object 10; second object/secondary tool 48; handle/elongated member 12; second retainer/magnetic member 50; axe 10; knife 48; fishing and hiking gear item in column 3, lines 45-47. Hall does not disclose a first retainer configured for attraction by a magnetic force. However, Escobedo teaches a first retainer configured for attraction by a magnetic force 20. It would have been obvious to provide a first retainer

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configured for attraction by a magnetic force in Hall as taught by Escobedo in order to reduce the possibility of mechanical failure of the locking mechanism. Note in Escobedo first retainer/magnetic member 20; magnetic force supplied by magnet/first retainer 20; first and second polarities are inherent in the attraction between metal materials and magnets; magnetic material 20; substantial alignment of tools in figures 3.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bachtold and Huston et al are cited for an axe with a knife retained in the handle receptacle.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 571-272-4509. The examiner can normally be reached on Monday through Friday between 8am and 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



IH  
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